#16

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED

JAN 4 - 1988

OFFICE OF THE DIRECTOR
GROUP 230

Re: Application of :
Martin G. Reiffin :
Serial No: 719,507 :
Filed: April 3, 1985 : On Petition
For: COMPUTER SYSTEM WITH REAL-TIME :
COMPILATION :

Applicant has filed a Petition under 37 CFR 1.181 requesting that the Commissioner invoke his supervisory authority to direct:

1. That the Examiner designate specifically, by drawing reference numerals and specification line numbers, wherein the cited Lawrence et al patent is alleged to disclose hardware or software for performing each of the functions relied upon by the Examiner as anticipatory or suggestive of any aspect of applicant's claims;

2. That, for each said function for which the Lawrence et al patent discloses neither hardware nor software for performing the function, the Examiner either submit an affidavit or cite a prior patent or publication showing that either hardware or software for performing the function in question was conventional at the time of filing of applicant's parent application Serial No. 425,612;

3. That the recited functions in the "means" clauses in applicant's claims, such as "compiling", "scanning", "parsing", "translating", "lexical analysis", "syntactic analysis" and similar functional limitations may not be ignored or dismissed by the Examiner as "merely labels of some functions" [sic], and that these recited functions instead be properly considered in determining the patentability of applicant's claims;

4. That the finality of the Action of September 18, 1987 be withdrawn; and

5. That a new date for applicant's response be set.

As to request 1 above, in the Final Action (Paper No.14), the Examiner has adequately identified the hardware/software elements (e.g., interpreter/formatter (6), editor (10) and relevant disclosure portions (e.g., col. 11, lines 51-54) of the Lawrence reference to allow one of ordinary skill in the data processing art to understand the basis of his obviousness rejection.

Request 1 above is therefore denied.

As to Request 2, applicant's arguments are deemed to be without legal support. For example, it has been held that when the Patent and Trademark Office has cited a prior art patent anticipating a claimed invention, the burden then shifts to applicant "to rebut the presumption of operability" of the cited patent by a preponderance of evidence. In re Sasse, 207 USPQ 107, 111 (CCPA 1980). Within the context of Sasse, the meaning of "operability" is equivalent to enablement. Other courts have similarly held that applicants bear the burden of introducing evidence that a prior art patent lacks an "enabling disclosure". In re Fracalossi et al, 215 USPQ 569, 570 (CCPA 1982); In re Baxter, 210 USPQ 795, 801 (CCPA 1981); In re Jacobs, 137 USPQ 888, 889 (CCPA 1963). Here, applicant has not presented a preponderance of evidence which overcomes the presumption of enablement of the Examiner's Lawrence reference, which is an issued United States patent.

Request 2 above is therefore denied.

With regard to request 3, in essence, the Examiner's position appears to have been that the broadly recited functions would have been recognized by an electrical engineer ordinarily skilled in the Data Processing arts as conventional or inherently obvious from the teachings of the Lawrence patent. Since this may not have been clearly apparent to applicant, request 3 is granted to the extent necessary for clarification in a subsequent action by the examiner discussed infra. It should be noted that the Board of Appeals is the proper forum for resolution of substantive matters relating to the interpretations of the technical teachings of a reference.

In view of other considerations (relating to the prior art) which have come to the attention of the Examiner and his supervisor, the action mailed September 18, 1987 is hereby withdrawn. A new action on the merits will be forthcoming in due course from the Examiner in charge of the application.

Request 4 above is therefore now moot as to the vacated action. However, it is to be understood that the new action will be a final action.

Request 5 is granted. The new date will be set (beginning a new three (3) month SSP) as of the mailing date of the forthcoming action from the Examiner.

The petition is denied and granted in part as indicated above.

Earl Levy
Director, Group 230

Martin G. Reiffin
545 Pierce Street Apt. 2404
Albany, Ca. 94706